

REMARKS

This paper is presented in response to the Office Action. Claims 1-4, 6-12, 15, 16, and 19-40 are pending.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks, or lack of remarks, set forth herein are not intended to constitute, and should not be construed as an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

II. Rejection of Claims 10, 11, 16, 19, and 40 under 35 U.S.C. § 102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP* § 2131.

The Examiner has rejected claims 10, 11, 16, 19, and 40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,222,114 to Kamata et al. ("*Kamata*"). Applicant respectfully disagrees.

In the rejection of claims 10 and 40, the Examiner alleges that *Kamata* discloses "means for facilitating focal spot control, wherein the means generates a magnetic field with a magnetic flux density B having flux lines that are substantially perpendicular to a direction of travel of the electron beam" as recited in claim 10. In support of that allegation, the Examiner has cited column 8, lines 34-43 of *Kamata*. However, Applicant has reviewed the cited passage of *Kamata* and has been unable to find any mention of "magnetic flux density" or "flux lines" in the cited section, let alone disclosure of a means that generates "... magnetic flux density B having flux lines that are substantially perpendicular to a direction of travel of the electron beam" as required by claims 10 and 40.

Inasmuch as the Examiner has not established that the identical invention is shown in *Kamata* in as complete detail as is contained in claims 10 and 40, Applicant respectfully submits that the Examiner has failed to establish that *Kamata* anticipates claims 10 and 40. Applicant thus respectfully submits that the

rejection of claims 10 and 40, as well as the rejection of corresponding dependent claims 11, 16 and 19, should be withdrawn.

III. Rejection of Claims 12 and 15 under 35 U.S.C. § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MEPE § 2143*.

The Examiner has rejected claims 12 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Kamata* in view of U.S. Patent No. 4,064,352 to Mann (“*Mann*”). Applicant respectfully disagrees.

As noted at II. above, the Examiner has failed to establish that *Kamata* teaches or suggests the claim 10 limitation “... means for facilitating focal spot control, wherein the means generates a magnetic field with a magnetic flux density B having flux lines that are substantially perpendicular to a direction of travel of the electron beam.” Moreover, the Examiner has not established that this defect of *Kamata* is remedied by *Mann* or any other reference. Thus, insofar as the rejection of claims 12 and 15 relies on the characterization of *Kamata* advanced by the Examiner in connection with the rejection of claims 10, 11, 16, 19, and 40 under 35 U.S.C. § 102(b), the rejection of claims 12 and 15 lacks an adequate foundation, for at least the reasons outlined at II. above, and should accordingly be withdrawn.

IV. Allowable Subject Matter

Applicant acknowledges with thanks the indication of the Examiner that claims 1-4, 6-9 and 20-39 are allowed, and Applicant also wishes to thank the Examiner for the careful review of those claims.¹

Applicant submits the following comments concerning the Examiner’s statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 1-4, 6-9 and 20-39 are respectively directed are patentable over the cited references, but respectfully disagrees with the Examiner’s statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is

¹ Although the Examiner stated that “claims 1-9 and 20-39 are allowed”, claim 5 was cancelled in a previous paper. Applicant therefore assumes that the Examiner meant to exclude claim 5 from the list of allowed claims. If this is not correct, Applicant respectfully requests that the Examiner advise Applicant accordingly.

properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 1-4, 6-9 and 20-39 in view of the cited references.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-4, 6-12, 15, 16, and 19-40 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 27th day of July, 2006.

Respectfully submitted,



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